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Winnie C. Durbin

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EXAMINER

SIMITOSKI, MICHAEL J

ART UNIT

PAPER NUMBER

2134

DATE MAILED: 07/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/683,561

Applicant(s)

DURBIN ET AL.

Examiner

Michael J. Simitoski

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The response of 5/12/2006 was received and considered.
2. Claims 1-29 are pending.

Response to Arguments

3. Applicant's arguments filed 5/12/2006 have been fully considered but they are not persuasive.
4. Applicant's response (pp. 7-16) argues that despite the Interim Guidelines for Examination of Patent Application for Patent Subject Matter Eligibility's statement that "such signal claims are ineligible for patent protection because they do not fall within any of the four statutory classes of §101", the rejection under §101 should be withdrawn because the limitations of claim 17 recite more than physical characteristics of a form of energy, but create a functional interrelationship with a computer. Claim 17 recites that when executed by a processor, the signal causes at least one processor to perform steps. Applicant's response argues that because Applicant's claim 17 creates a functional interrelationship with a computer and recites more than physical characteristics of a form of energy, such as a frequency, voltage or the strength of a magnetic field, define energy or magnetism, per se. However, applicant has failed to address which statutory class of invention under which claim 17 falls. Therefore, it is maintained that the claimed subject matter is not eligible subject matter for patent protection under the four statutory classes under §101, as suggested by the interim guidelines.

Applicant's response (pp. 10-16) further argues the propriety of claim 17 by citing issued patent claims and further cites issued patent claims with listed Primary Examiners coincident

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with the instant application. However, it is not within the purview of this Examiner to comment on the validity of previously issued patent claims. All issued patents are assumed valid (35 U.S.C. §282). The fact remains that Applicant's response has failed to supply persuasive arguments as to a specific statutory class under which the invention of claim 17 falls. As the Interim Guidelines, as cited in the previous Office Action, maintain that a signal does not fall within the statutory classes of invention provided under 35 U.S.C. §101, the rejection is maintained.

Applicant's response (pp. 17-18) requests withdrawal of the objection to the specification and rejection of claim 29 under 35 U.S.C. §112, ¶1. In light of Applicant's amendments to claim 29, the objection to the specification and rejection under §112 are withdrawn.

Applicant's response (p. 18) draws to attention the withdrawal of the §112, ¶2 rejection of claims 1, 17 & 22 (§§14a, c, & e of the Final Office Action) as stated in the Advisory Action; this withdrawal is confirmed. However, it is noted that §§14b & d have not been addressed. Regarding claims 10 & 22, the specification does not describe a remotely-located user to input an activation code into the stand-alone device. The specification discloses the user inputting the activation code using a keypad attached to the stand-alone device. Therefore, this limitation is unclear.

Applicant's response (pp. 20-21) argues that none of the references teach a "computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility

and the remote stand-alone device”. However, the rejection presented in the Final Office Action conveys the Examiner’s position that Steinmetz in view of Whigham renders the claim(s) obvious. Applicant argues each reference separately as not teaching a feature of the combined invention. However, as stated in the Office Action, each reference is not relied upon individually, but rather the combination of the references. It is maintained that the references, in the cited combination(s), teach a sequence of instructions which, when executed by the at least one processor, causes the at least one processor to received, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device.

Applicant's response (p. 24) argues that “The transaction record 124 created by the server 120 in response to the request for the product 104 and that includes the inventory record 128 and the billing record 130, fails to disclose, inter alia, the user request to self-enable a disabled option resident on the device.” It is unclear to which portion of the claim or Office Action applicant is referring, however, Steinmetz discloses a user request to self-enable a disabled option on the device (col. 3, lines 54-61).

Applicant's response (pp. 24-25) argues that Fenstermaker fails to disclose a “computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device”. It is maintained that the references, in the cited

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combination(s), teach a sequence of instructions which, when executed by the at least one processor, causes the at least one processor to received, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device.

Applicant's response (pp. 25-26) argues that Rive fails to disclose a “computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device”. It is noted that Rive is not relied upon for teaching the user “being remote from the centralized facility and the remote stand-alone device”. It is Rive, in combination with Whigham and Fenstemaker, which is relied upon. It is maintained that the references, in the cited combination(s), teach a sequence of instructions which, when executed by the at least one processor, causes the at least one processor to received, at the centralized facility, the request to activate the option resident in the memory of the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device.

Applicant's response (p. 27) argues that Mccown, Castagna, Dutta, Rose and Takae fail to disclose a “computer data signal embodied in the carrier wave and representing the sequence of instructions which, when executed by the at least one processor, causes the at least one processor to receive, at the centralized facility, the request to activate the option resident in the memory of

the remote stand-alone device from the user of the remote stand-alone device remote from the centralized facility and the remote stand-alone device”. However, it is noted that Mccown, Castagna, Dutta, Rose and Takae are not relied upon in rejecting claim 17.

Applicant's response (p. 27) argues that “the Office Action does not allege that the art of record provides any teaching, suggestion or incentive for modifying the citations to Steinmetz, Whigham, Fenstemaker, Rive, Mccown, Castagna, Dutta, Rose and/or Takae to provide the claimed approach.” However, the previous Office Action and the current Office Action each provide motivation regarding all proposed combinations.

5. Applicant's response (pp. 28-29) argues that the Examiner must cite a reference regarding the Official Notice taken on claim 3 that it is well established in the art of renting/leasing to rent an item for thirty days as a method of allowing a user to access an option for one month (§18 of the previous Office Action). Applicant also states “the Examiner must establish that such was well known at the time of invention and within the context and use claimed. Applicants believe that at the time of invention, enabling user access to the non-enabled option resident on the device for a trial period of thirty days was not old and well established.” As stated in the previous Office Action, Rive discloses enabling access for a predetermined period of time (renting) (col. 16, lines 37-41 & lines 62-67). Rive lacks the time period being thirty days. However, U.S. Patent Application Publication 2001/0034712 to Colvin teaches a system where software is provided use in an authorization interval, which requires a password for continued use for another interval, where the authorization interval is based on a calendar or date and corresponds to 30 days (§50). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to enable the software for a

trial period of thirty days. One of ordinary skill in the art would have been motivated to perform such a modification because the interval is based on a calendar, which allows for easier management and monitoring. The Examiner cites U.S. Patents 5,790,664 to Coley et al. (col. 2, lines 27-40), 5,845,065 to Conte et al. (col. 24, lines 42-65) and 6,243,692 to Floyd et al. (col. 2, lines 8-17) for teaching enabling disabled software for a period of thirty days, where software is enabled by purchasing the temporary enablement. Further, U.S. Patent Application Publications 2002/0029347 to Edelman (34-35, 89, 94, 98 & 132-133), 2001/0034712 to Colvin (50), 2002/0108054 to Moore et al. (29) and 2002/0128842 to Hoi et al. (54, 56, 60 & 67-68) are cited for teaching enabling software for a period of thirty days. These references are provided in support of the obviousness of thirty-day time period claimed.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 17-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a computer data signal, which does not fall within one of the four statutory classes of invention under §101.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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9. Claim 10-16, 22-26 & 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not a remote user entering an activation code into the device.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 10-16, 22-26 & 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 10, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device.

b. Regarding claim 22, it is unclear how the user can input an alphanumeric code on the data entry module of the stand-alone device if the user is remote from the device.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 10-12, 17-19, 22-24 & 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,672,505 to Steinmetz et al. (**Steinmetz**) and U.S. Patent 6,584,309 to **Whigham**.

Regarding claims 10-12 & 17-18, Steinmetz discloses instructions to receive, at a centralized facility/licensing authority (col. 9, lines 31-34), a request to activate an option/configuration (col. 9, lines 31-34) resident in memory of a remote stand-alone device/ATM from a user (col. 16, lines 9-18) remote from the centralized facility/licensing authority (col. 9, lines 54-64), determine whether the user is qualified (has paid) (col. 16, lines 9-18) and if so, grant access to the option resident in the remote stand-alone device (col. 9, lines 62-64) for a limited time period (col. 10, line 61 – col. 11, line 2), generate a software key/authorization key designed to allow access to the option for the limited time period (col. 9, lines 31-44 & col. 10, line 61 – col. 11, line 2) and send the software key to the user (col. 9, lines 11-30). Steinmetz lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote from the centralized facility and the remote stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection

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between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 19, Steinmetz discloses receiving a user identifier/Customer ID, receiving a system identifier/Terminal ID and receiving an option identifier/Configuration ID (Fig. 5) and to generate the software key to be specific to the user, the system and the option (col. 10, line 57 – col. 11, line 8).

Regarding claims 22-23, Steinmetz discloses a graphical user interface configured to facilitate user activation of a disabled option resident on a device (Fig. 5), receive a number of user inputs from a user remote from the device (licensing authority receives requests) (col. 9, lines 33-34 & col. 10, lines 57-62), generate an alphanumeric code/authorization key configured to activate the disabled option upon user inputting of the alphanumeric code/authorization key on a data entry module/keyboard of the device (col. 5, lines 14-25) and automatically convey the alphanumeric code to the user (col. 11, line 66 – col. 12, line 1). Steinmetz lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz to allow the user to be remote from the centralized facility and the remote stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate

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the need for a dedicated online connection between the remote stand-alone device and the licensing authority, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47).

Regarding claim 24, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2).

Regarding claim 26, Steinmetz discloses instructions causing the computer to determine a period of delay, the period of delay representing a time to allow the user to activate the disabled option (col. 10, line 66 – col. 11, line 2), but lacks the period of delay being 24 hours. However, absent any showing of criticality, it would have been obvious to choose the expiration period to be 24 hours.

14. Claims 20 & 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz** and **Whigham**, as applied to claim 17 above, in further view of U.S. Patent 6,490,684 to Fenstemaker et al. (**Fenstemaker**). Steinmetz discloses an encrypted alphanumeric identifier (col. 5, lines 57-59), but lacks the device being a medical imaging scanner. However, Fenstemaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

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15. Claims 1-5, 7-12, 16-18 & 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,301,666 to **Rive, Whigham and Fenstermaker**.

Regarding claims 1, 4-5, 7, 10, 12 & 16-18, Rive discloses receiving a request and I.D. data from a user of a remotely located stand-alone device/client (col. 16, lines 44-49 & col. 17, lines 32-36) seeking access to a non-enabled option resident on the device (col. 17, lines 37-43), generating an electronic enabler/one-time password configured to enable the non-enabled option, transmitting the electronic enabler to the user and providing instructions to the user to install the electronic enabler/one-time password in the remotely located stand-alone device to activate the option on the remotely located stand-alone device (col. 17, lines 48-55). Rive lacks the user being remote from the centralized facility and the remote stand-alone device. However, Whigham teaches a vending system where the user uses a cellular phone to request and purchase a product from a machine (col. 4, lines 10-14) that is received by a server/centralized facility (col. 4, lines 10-14), which then automatically delivers a vend code to the user (col. 4, lines 53-61) and can be transmitted to the machine (col. 4, lines 65-67). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to send the instructions and an electronic enabler to the user's phone, remote from the stand-alone device. One of ordinary skill in the art would have been motivated to perform such a modification to eliminate the need for a dedicated online connection between the remote stand-alone device and the, as taught by Whigham (col. 4, lines 10-14, lines 53-67 & col. 7, lines 43-47). Rive, as modified above, lacks the device being a medical imaging device. However, Fenstermaker teaches that it is beneficial for users to try certain features of an ultrasound device without adding any hardware (col. 1, lines 21-32). Therefore, it would have been obvious to one

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having ordinary skill in the art at the time the invention was made to selectively enable options on a medical imaging device. One of ordinary skill in the art would have been motivated to perform such a modification because there is a need in the art to do so, as taught by Fenstemaker (col. 1, lines 21-32).

Regarding claim 2, Rive discloses enabling access for a predetermined period of time/renting (col. 16, lines 37-41 & lines 62-67).

Regarding claim 8, Rive discloses generating the electronic enabler upon user satisfaction of a user account/profile (col. 16, lines 43-46).

Regarding claim 9, Rive discloses a centralized facility/supplier (col. 17, lines 38-44) by a user at a workstation remote from the centralized facility, but lacks explicitly a graphical user interface. However, Rive discloses that the request can be sent via email or web (col. 17, lines 33-37), and it is held that both email and web based communication require a graphical user interface. Further, Rive, in combination with Whigham, discloses forming a request via a cell phone/graphical user interface.

Regarding claim 11, Rive discloses emailing the alphanumeric code/password (col. 17, lines 49-55).

Regarding claims 20-21, Rive, as modified above, lacks the alphanumeric code being encrypted. However, Fenstemaker teaches that encrypting an authorization key reduces the likelihood of unauthorized use of a feature/option (col. 5, lines 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to encrypt the software key. One of ordinary skill in the art would have been motivated to

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perform such a modification to reducing reduce the likelihood of unauthorized use of a feature/option, as taught by Fenstermaker (col. 5, lines 1-3).

16. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham** and **Fenstermaker**, as applied to claim 2 above, in further view of U.S. Patent Application Publication 2001/0034712 to **Colvin**. Rive explicitly lacks enabling access for a trial period of thirty days. However, Colvin teaches a system where software is provided use in an authorization interval, which requires a password for continued use for another interval, where the authorization interval is based on a calendar or date and corresponds to 30 days (§50).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Rive to enable the software for a trial period of thirty days. One of ordinary skill in the art would have been motivated to perform such a modification because the interval is based on a calendar, which allows for easier management and monitoring.

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham** and **Fenstermaker**, as applied to claim 12 above, in further view of U.S. Patent Application Publication 2002/0124168 to Mccown et al. (**Mccown**). Rive, as modified, discloses a medical imaging scanner (Fenstermaker, col. 1, lines 21-32), but lacks explicitly disabling the activated option upon expiration of the predetermined and limited time. However, Mccown teaches that one method of licensing components on a computer is to lease a component, wherein when a lease is expired the options on the device are disabled/unstrapped (§43) to inexpensively upgrade a computing environment (§6). Therefore, it would have been obvious to one having ordinary

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skill in the art at the time the invention was made to modify Rive to disable the activated option upon expiration of the predetermined and limited time/lease expiration. One of ordinary skill in the art would have been motivated to perform such a modification to inexpensively upgrade a computing environment, as taught by Mccown (§6 & ¶43).

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham** and **Fenstermaker**, as applied to claim 10 above, in further view of **Steinmetz**. Rive lacks prompting the user to input a user identifier, a system identifier, a stand-alone identifier and a disabled option identifier, generate an electronic license contract and prompt the user to either accept or decline the license contract. However, Steinmetz teaches a user entering a user identifier/Customer ID, a system identifier/Terminal ID (Fig. 5), a stand-alone device identifier/Processor ID (col. 5, lines 26-35) and a disabled option identifier/Configuration ID (Fig. 5) and prompting the user to accept the license terms before enabling the ATM to be configured (col. 13, lines 55-62). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to input a set of data, generate an electronic license contract and prompt the user to either accept or decline the license contract. One of ordinary skill in the art would have been motivated to perform such a modification to compare configuration data to verify the activation key and to enable the ATM according to a license agreement, as taught by Steinmetz (col. 3, lines 23-27, col. 4, lines 29-41, col. 5, lines 26-35, col. 13, lines 55-62 & Fig. 5).

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19. Claim 6 & 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive, Whigham and Fenstermaker**, as applied to claims 1 & 10 above, in further view of “Something for Nothing – Phone for free, save on books, or build a home page on the house. The Web offers an abundance of free stuff-but watch out for strings” by **Castagna**. Rive, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor’s application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2).

20. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz and Whigham**, as applied to claim 24 above, in view of **Castagna** and U.S. Patent Application Publication 2002/0078177 to **Dutta**. Steinmetz, as modified above, lacks emailing an electronic request to the user upon expiration of the period of delay. However, Castagna teaches that demoware is a limited version of a commercial vendor’s application you try for a time before it disables (p. 2, ¶3) and that when downloading the application, an email address is collected so the vendor can follow up and try to sell the user the full version (p. 2, ¶5). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made transmit a request for verification of enablement. One of ordinary skill in the art would have

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been motivated to perform such a modification to follow up with the user to entice a user to purchase the option, as taught by Castagna (p. 2). As modified, Steinmetz performing the emailing specifically upon expiration of the period of delay. However, Dutta teaches that to entice a user to buy a subscription, a merchant can contact a user when a trial subscription ends in hopes the user will purchase a subscription (§7). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to send the email upon the expiration of the period of delay. One of ordinary skill in the art would have been motivated to perform such a modification to entice a user to buy a subscription, as taught by Dutta (§7).

21. Claims 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Rive**, **Whigham**, and **Fenstemaker**, as applied to claim 1 above, in view of U.S. Patent 5,708,709 to **Rose**. Rive, as modified above, lacks conveying a follow up message to the user prior to an expiration of a trial period for which the user is enabled access. However, Rose teaches that a soft expiration date, where the user is warned that at the a future termination date, the user will need to obtain a licensed copy of an application program (col. 11, lines 16-23), avoids suddenly preventing use of the application and ensures the user is warned of expiration (col. 11, lines 23-34). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to convey a follow up message to the user prior to the expiration of a trial period. One of ordinary skill in the art would have been motivated to perform such a modification to avoid suddenly preventing use of the application and ensure the user is warned of expiration, as taught by Rose (col. 11, lines 16-34).

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22. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Steinmetz, Whigham, Castagna and Dutta**, as applied to claim 25 above, in view of U.S. Patent 6,795,703 to Takae et al. (**Takae**). Steinmetz, as modified above, lacks further causing the computer/licensing authority to automatically accept a verification email from the user verifying self-activation of the disabled option. However, Takae teaches that if a verification email is accepted from a user who has just activated a handset, the verifier is assured that the activation was successful without visiting a particular location (col. 5, lines 5-25 & lines 42-49). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Steinmetz's licensing authority to automatically accept a verification email from the user verifying self-activation. One of ordinary skill in the art would have been motivated to perform such a modification to inform the licensing authority that the activation was successful without visiting a particular location, as taught by Takae (col. 5, lines 5-25 & lines 42-49).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Simitoski whose telephone number is (571) 272-3841. The examiner can normally be reached on Monday - Thursday, 6:45 a.m. - 4:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jacques Louis-Jacques can be reached on (571) 272-6962. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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MJS



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